



REMARKS

1. Applicants have amended the title to reflect that the article claims have been canceled pursuant to the Examiner's restriction requirement.
2. Applicants have canceled Claims 1-8 pursuant to the Examiner's restriction requirement.
3. The Examiner did not return the Information Disclosure Statement filed by Applicants on September 18, 2000. The Examiner noted that the references cited were not submitted to the Examiner. Applicants actually submitted a large stack of materials with the IDS. Apparently they were misplaced in the PTO. Applicants are having another copy of the IDS and the references hand-delivered to the Examiner. Applicants request the Examiner to initial and return the Applicants' PTO Form 1449 with the next office action or the Notice of Allowance.
4. Applicants will be filing a Third Supplemental IDS in the near future. Applicants request the Examiner to initial and return the PTO Form 1449 to Applicants with the next communication from the PTO.
5. Claims 9, 12, and 13 have been rejected under Section 102(b) as anticipated by U.S. Patent No. 4,472,328 to Sugimoto. Applicants respectfully traverse the Examiner's rejections based on 102(b). Applicants respectfully submit that the cited prior art does not anticipate the invention described and claimed in the present application since the prior art reference does not meet the test for anticipation. The Federal Circuit has made very clear that anticipation requires **both** that:

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each and every element of the claimed invention be disclosed in a prior art reference. *Akzo N.V. v. U.S. Intern. Trade Com'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1984). In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V.*, 808 F.2d at 1479, citing *In re Brown*, 329 F.2d 1006, 1011 (C.C.P.A. 1964), see also, *Application of Carlos M. Smaour*, 571 F.2d 559 (C.C.P.A. 1978), in turn citing, *inter alia*, *In re Coker*, 463, F.2d 1344, (C.C.P.A. 1972). Whether the claimed subject matter was "in the possession of the public" depends on "[w]hether a method of preparing the claimed subject matter would have been known by, or would have been obvious to, one of ordinary skill in the pertinent art." *In re Brown*, 329 F.2d at 1011.

Put another way, "To be prior art under section 102(b), the reference must put the anticipating subject matter at issue into the possession of the public through an enabling disclosure." *Chester v. Miller*, 906 F.2d 1574 (Fed. Cir. 1990).

Applicants contend that the prior art reference cited by the Examiner does not anticipate the instant invention both because (a) each and every element of the claimed invention is not disclosed in the cited reference; and (b) because the prior art reference is not enabling -- that is, Sugimoto does not disclose the instant invention sufficient to place it "in the possession of the public."

- A. The prior art does not anticipate the claimed invention since each and every element of the claimed invention is not disclosed in a single prior art reference.**

Anticipation requires that each and every element of the claimed invention be disclosed in the prior art. *W.L. Gore & Associates, Inc.*, 721 F.2d at 1554. The reference cited by the Examiner, Sugimoto, discloses a "process for producing a porous film or sheet." Applicants' independent Claim 9 as amended includes the step of "combining said polyolefin precursor/filler with an additive selected from a group including a plastomer, an elastomer, a styrenic block copolymer or a combination thereof." Sugimoto does not disclose a method of producing a porous film or sheet that includes the step of "combining said polyolefin precursor/filler with an additive selected from a group including a plastomer, an elastomer, a styrenic block copolymer or a combination thereof." Sugimoto discloses polyhydroxy saturated hydrocarbon polymers obtained by hydrogenating hydroxy-terminated liquid polybutadiene (Sugimoto, col. 2, line 54 to col. 3, line 42). Polyhydroxy saturated hydrocarbon polymers are not referred to in the art as plastomers, elastomers or styrenic block co-polymers. Therefore, Claim 9 recites method limitations that are not disclosed in the Sugimoto reference

- B. The disclosures in the prior art do not sufficiently "disclose" the claimed invention sufficient for § 102 purposes.**

The reference cited by the Examiner, Sugimoto, discloses a "process for producing a porous film." However, the disclosure of Sugimoto provides no guidance to one skilled in the art for adding a plastomer, elastomer or styrenic block copolymer to improve the dart impact and tear strength of the porous film of Sugimoto.

For the reasons discussed above the independent Claim 9 is not anticipated by Sugimoto. The dependent claims 12 and 13 necessarily include the limitations of their respective independent claims and are therefore not anticipated by Sugimoto.

6. The Examiner has rejected Claims 10 and 11 under Section 103 as being unpatentable over Sugimoto in view of Schwarz. Applicants believe that Claims 10 and 11 are allowable as originally submitted because neither Sugimoto alone nor in combination with Schwarz teach the limitation of including a plastomer, elastomer or styrenic block copolymer to form a microporous breathable film having a dart impact strength in the range of from about 100 to about 300 grams, wherein said film has a WVTR in the range of from about 100 to about 10,000 f/m²/24 hr, and wherein said film has an MD or TD elongation in the range of from about 150% to about 550%."

Indeed, Schwarz discloses a method of stretching a film to produce a "porous sheet or film useful as a printing substrate, such as synthetic paper; as a substitute for leather; as a **highly fibrillated sheet which can easily be shredded into fine fibrils** to be used as substitutes for paper-making pulps or as filler materials such as battery separators." (Schwarz, col. 1, lines 17-22 (emphasis added)). Indeed, such a highly fibrillated sheet that is easily shreadable is teaching away from the improved tear strength, stretchability and softness of the microporous film of Applicants' invention that is used for baby diapers, sanitary pads and other necessarily durable products. When one reference teaches away from the invention that is the subject of the application, it is not properly combinable with other references, as there would have been no motivation to combine the teachings of the references. "When the motivation to combine the teachings

of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." MPEP 2142 at 2100-89.

The Federal Circuit has set forth the law regarding the patentability of a combination of known elements. When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *In re Denis Rouffet, Yannik Tanguy and Frederic Berthaourt*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). Therefore, when determining patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the combination. *Id.* There is no motivation to combine Sugimoto and Schwarz because Schwarz teaches away from the Applicants' invention. Applicants respectfully traverse the rejection and submits the Examiner has not carried his burden in combining the references.

Additionally, the application recites dramatic improvements in the physical properties of the subject film that were "unexpected and surprising." (Application, page 7, lines 2-13.) Applicants submit that it was **not known** until Applicants' invention thereof that the addition of plastomers, elastomers or styrenic block copolymers would allow a film of primarily polypropylene to be stretched using IMG rollers to result in a porous non-brittle film. In the background section Applicants note that "prior art polypropylene films oriented by traditional machine direction orientation, transverse direction orientation, or biaxial orientation (all well known in the art) have exhibited very low tear and impact strength (Application, page 6, lines 1-4). However, through the addition of a minority amount of elastomer or a plastomer the dart impact strength was

more than triple that found in previously available oriented polypropylene breathable films and the transverse direction tear strength is more than triple that found in previously available oriented polypropylene breathable films. (Application, page 7, lines 4 – 12). Therefore, Applicants submit claims 10 and 11 are not obvious in view of the cited prior art.

7. Dependent Claims 14 and 15 are rejected under Section 103 as being unpatentable over Sugimoto in view of McCormack. Applicants have amended Claims 14 and 15 to have them depend directly and indirectly from Claim 10. Therefore Claims 14 and 15 incorporate the limitations of Claim 10 and are allowable for the reasons discussed above.

Additionally, Applicants have further amended the claims to include limitations of heat lamination of a breathable film having polypropylene as a major component of the polyolefin precursor to a nonwoven having polypropylene as a major component of the polyolefin used to form the nonwoven. Prior to Applicants' invention of a polypropylene breathable film having the desired properties described and claimed herein, polyethylene breathable films were the films of choice due to desirable softness and strength. However, lamination of prior art polyethylene films to polypropylene nonwovens encountered substantial problems due to the difference in the melting points of the polypropylene nonwoven (about 161°C) and the polyethylene film (about 125° C). When using heat lamination, in order to have adequate lamination bond strength between the two materials, pin holes or damage to the filled polyethylene film occurred at the bond site to the polypropylene nonwoven material. (Application, page 5, lines 7-19).

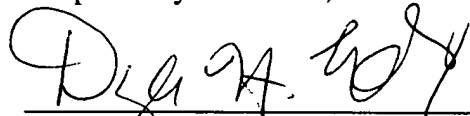
Applicants' invention of a polypropylene filled film with desirable properties that allow for heat lamination to a polypropylene nonwoven was not obvious.

CONCLUSION

Thus, all grounds of rejection and/or objection are traversed or accommodated, and favorable reconsideration and allowance are respectfully requested.

Please charge any additional fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit Account No. 20-0782/EXXO/004/DHE.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. H. Elliott", written over a horizontal line.

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